

REMARKS

In the Final Office Action,¹ the Examiner:

- 1) objected to the specification,
- 2) rejected claims 1, 4-13, 16-25, 28-37, and 40-56 under 35 U.S.C. § 112, first paragraph,
- 3) rejected claims 1, 4-13, 16-25, 28-37, 40-49, 51, 53 and 55 under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 5,422,821 to *Allen*, and
- 4) rejected claims 50, 52, 54, and 56 under 35 U.S.C. § 103 as unpatentable over *Allen* in view of U.S. Patent No. 5,422,821 to *Cordery*.

In the Advisory Action, the Examiner:

- 1) rejected claims 1, 4-13, 16-25, 28-37, and 40-56,
- 2) withdrew the objection to the specification, and
- 3) withdrew the rejection of claims 1, 4-13, 16-25, 28-37, and 40-56 under 35 U.S.C. § 112, first paragraph.

Claims 1, 4, 6, 13, 16, 18, 19, 25, 28, 30, 31, 37, 40, 42, and 43 have been amended and claims 1, 4-13, 16-25, 28-37, and 40-56 remain pending.

As a preliminary matter, the Examiner refers to an “Adam” reference on page 14 of the Final Office Action. For purposes of responding, Applicants assume this should have read “Allen.” Applicants request the Examiner’s clarification if this assumption is not correct.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

Applicants respectfully traverse the rejection of 1, 4-13, 16-25, 28-37, 40-49, 51, 53 and 55 under 35 U.S.C. § 103. No *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, the Examiner must, among other things, determine the scope and content of the prior art and ascertain the differences between the claimed invention and the prior art. See M.P.E.P. § 2144.08(II)(A), 8th Ed., Rev. 6 (September 2007). Furthermore, the Examiner must make findings with respect to all of the claim limitations and must make “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See M.P.E.P. §§ 2143.03 and 2141(III).

Claim 1 recites, *inter alia*, “receiving . . . an incorrect address associated with a first item; . . . storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address; receiving a second instance of the incorrect address associated with a second item; comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address; and outputting the correct address from the database,” as claimed.

The Examiner alleges that “Allen lacks an explicit teaching of a “second instance,” but also alleges that “receiving a second instance of the incorrect address” and “comparison of a second instance of the incorrect address” is “merely a re-checking step.” Advisory Action, page 2 and Final Office Action, page 4. The Examiner also alleges that “it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to modify the system of Allen to include receiving a second

instance of the incorrect address and performing a comparison in order to repeat the address correction process for any subsequent mail pieces addressed to the same receiver.” Final Office Action, pages 4-5. These allegations do not render claim 1 obvious.

Claim 1 recites “comparing the second instance of the incorrect address to the stored resolved address.” *emphasis added*. That is, the “comparison” step, as claimed, does not invoke a repetition of the address correction process, as alleged by the Examiner in the Final Office Action at pages 4-5. Instead of repeating the address correction process, the claim recites “comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address; and outputting the correct address from the database based on the determination.”

In addition, *Allen* does not “receiv[e] a second instance of the incorrect address associated with a second item,” “compar[e] the second instance of the incorrect address to the stored resolved address” and “output[] the correct address from the database” as claimed. Instead, *Allen* compares a “destination address and addressee name to a list of incorrect destination addresses and addressee names” for a single mailpiece. Column 15, lines 60-67. *Allen* can then identify and store a “forwarding address in a memory at an addressed [sic] identified with a unique mailpiece identification code affixed to the incorrectly addressed mailpiece.” Column 16, lines 39-45. The “forwarding address” can be applied to the “incorrectly addressed mailpiece.” Column 16, lines 50-56. However, *Allen* does not use the stored forwarding address for a “second instance of the incorrect address associated with a second item,” as claimed.

That is, *Allen* repeats the address correction process, as noted by the Examiner. *Allen* does not “receiv[e] a second instance of the incorrect address associated with a second item,” “compar[e] the second instance of the incorrect address to the stored resolved address” and “output[] the correct address from the database,” as claimed.

Also, “receiving a second instance of the incorrect address” and “comparison of a second instance of the incorrect address” is not “merely a re-checking step,” as alleged by the Examiner in the Final Office Action at page 4. The “receiving” and “comparing” steps ultimately lead to a “determination” that allows for “outputting the correct address from the database,” as claimed. Therefore, “mere” “re-checking” would not result in the claimed combination of “receiving,” “comparing,” and “outputting,” as claimed.

For at least these reasons, the Final Office Action fails to establish a *prima facie* case of obviousness with respect to claim 1, at least because the prior art fails to teach each and every element required by the claim. Therefore, the rejection should be withdrawn.

Regarding the rejection of claims 50, 52, 54, and 56, the Examiner alleges that *Cordery* teaches a method “when the incorrect address does not match the stored first instance of the incorrect address.” Final Office Action, page 13. Even assuming that this allegation is true, which Applicants do not concede, *Cordery* fails to cure the deficiencies of *Allen* discussed above. That is, *Cordery* does not teach or suggest the combination of “receiving,” “comparing,” and “outputting,” as claimed.

In view of the foregoing, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, findings have not been made, and

reasons have not been clearly articulated, as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Accordingly the prior art fails to establish a *prima facie* case of obviousness with respect to claims 50, 52, 54, and 56, at least because the prior art fails to teach each and every element required by the claim.

Claims 13, 25, and 37, though of different scope from claim 1, recite elements similar to those set forth above for claim 1. Claims 13, 25, and 37 are therefore allowable for at least the reasons presented above with respect to claim 1. Claims 4-12, 16-14, 28-36, and 40-56 respectively depend from claims 1, 13, 25, and 37 and are allowable at least for the reason of their dependency. Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 103.

In view of the foregoing remarks, Applicants submit that the claims are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: June 24, 2008